



SEP 24 2002

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SMITH & HOPEN PA  
15950 BAY VISTA DRIVE  
SUITE 220  
CLEARWATER FL 33760

In re Application of  
Heller, Loree, et al.  
Application No. 10/064,512  
Filed: July 23, 2002  
For: METHOD OF ENHANCING  
THERAPEUTIC EFFECT OF NUCLEIC ACIDS

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: Decision on Petition  
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This is in response to the "Petition for Accepting Color Photographs and Suspending the Rules" under 37 CFR 1.84 and 37 CFR 1.183 respectively, filed August 30, 2002 in the above referenced application.

As explained below, the petition under 37 CFR 1.183 is **GRANTED**. The Petition under 37 CFR 1.84 to accept color drawings will be decided in the Technology Center.

The petition is two petitions and as explained below only the waiver under 37 CFR 1.183 is treated in this decision.

The above referenced application was filed electronically using the Electronic Filing System (EFS) with two sheets of color photographs. The standard for submitting drawings including color photographs are provided for in 37 CFR 1.84(b)(2) which incorporates the limitations in 37 CFR 1.84(a)(2) which does not permit the electronic filing of color photographs:

§ 1.84 Standards for drawings.

(a) Drawings. There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) Black ink. Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

(2) Color. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, *or copy thereof, submitted under the Office electronic filing system.* (emphasis added) The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

- (i) The fee set forth in § 1.17(h);
- (ii) Three (3) sets of color drawings;
- (iii) A black and white photocopy that accurately depicts, to the extent

possible, the subject matter shown in the color drawing; and

(iv) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

(b) Photographs .—

(1) Black and white . Photographs, ...

(2) Color photographs . Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

Although the guidelines for EFS filings provides a waiver of all inconsistent rules where the guidelines have been followed the EFS guidelines do not permit filing color drawings. The introduction to EFS, version 4.1 of May 2001, at pages 7 and 19, instructs that images are to be provided as black and white. This is further emphasized at page with "...EFS does not accept color drawings/images."

The EFS filing of color photographs is not consistent with the 37 CFR 1.84 or any waiver of rules provided by the EFS filing guidelines. Hence the petition under 37 CFR 1.183 is required for acceptance of the color photographs filed using EFS

Petitions for suspensions of the rules, 37 CFR 1.183 are decided by the Office of the Deputy Commissioner for Patent Examination Policy. See MPEP § 1002.02(b) item 2. Accordingly, only the portion of the petition requesting a suspension of the rules is addressed in this decision.

The Office processes normally will not be able to detect and print color drawings/photographs and print them in color if filed using EFS. Under the special circumstances in this application the Office did detect the color photographs but was not able to print an adequate black and white copy. With additional special handling as a result of this petition the Office was able to make a color print of the color photographs filed using EFS. Accordingly, the petition under 37 CFR 1.183 is **GRANTED** and the requirement precluding filing color photographs using EFS is waived. However, applicant should not file any additional color drawings/photographs when using EFS in the future since they may not be detected and printed in color.

Since variations are possible in computer printer ink colors, applicant should inspect the Office printed version of the color photographs at the earliest possible time to verify that the photographs accurately depict the subject matter sought to be portrayed. The requirement for an additional 2 sets (for a total of 3 sets) of color photographs is not waived with this decision and the two additional sets must be filed in paper. The two additional sets should be filed by applicants for verifying the accuracy of the Office printed version of the EFS submission. The additional two sets of photographs should be filed when the portion of the petition under 37 CFR 1.84 is decided.

The portion of the petition for acceptance of the color drawings/photographs are decided by the supervisory patent examiner and not addressed in this decision. See MPEP § 1002.02(d) item 10.

This application is being sent to the Office of Initial Patent Examination (OIPE) for further processing the color printing of the EFS photographs originally filed. After processing the color photographs originally filed, the application will be sent to Technology Center 1600 to address the petition under 37 CFR 1.84 for acceptance of color photographs.


Any correspondence with respect to this matter should be addressed as follows:

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*for*   
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